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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,486

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Bruce McGarian

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25269

7590

10/14/2008

DYKEMA GOSSETT PLLC
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EXAMINER

ANDREWS, DAVID L

ART UNIT

PAPER NUMBER

3672

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,486	Applicant(s) MCGARIAN ET AL.	
	Examiner David Andrews	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45 and 46 is/are allowed.
- 6) ☒ Claim(s) 33-39, 41, 42 and 47 is/are rejected.
- 7) ☒ Claim(s) 40, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed 6/26/2008 has been entered.

Response to Arguments

Applicant's arguments filed 6/26/2008, with respect to the 102 rejections under Gano have been fully considered but they are not persuasive.

Applicant argues that 102 rejections under Gano by stating that since item 110 is part of the wellbore casing it cannot be reasonably interpreted to form part of the body of a downhole deflector tool. The examiner disagrees. The casing section 110 is considered part of the tool since it has a necessary function in providing the window, holding the tool in the borehole and is connected to the remaining tool portions (via 116, 118). It is also "movably insertable into a borehole" as is known with casing installations.

Applicant's arguments with respect to claim 47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 33-39, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Gano (US 6,053,254). Gano discloses a downhole deflector tool (and method) which is movably insertable into a borehole for selectively opening and closing a lateral borehole extending from a primary borehole, the tool comprising: a body incorporating a wall provided with an opening extending therethrough (110; opening is the lateral borehole); a hollow tubular deflector member (136) slidably mounted in the body (col. 4, lines 46-52) and having a deflecting surface for deflecting downhole equipment laterally within the body (figure 3); the deflector being slidable between an open position, in which the deflecting surface is located adjacent and facing towards said body opening so that downhole equipment laterally deflected by the surface is directed through the opening (figure 3); and a closed position in which the deflector member is oriented relative to the body opening so as to prevent downhole equipment from being laterally deflected through the opening (figure 2); and constraining means for restricting movement of the deflector member relative to the body (col. 4, lines 25-55); wherein the constraining means comprises a pin and groove arrangement (col. 4, lines 53-55); wherein the pin and groove arrangement is such that the deflector member must move axially between two different closed positions before being able to move axially to the open position (the apparatus is considered to have multiple closed positions, which are all those except the open position, and many of these closed positions would be cycled through when opening); wherein the constraining means comprises a shoulder defined by the body and against which the deflector abuts when in the open position (125A); wherein the hollow bore interior of the deflector member comprises first and

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second, the first portion (figure 3, cross-section near where reference character 110 is pointing) having a larger diameter than the second portion (figure 3, cross-section near where reference character 124 is pointing), wherein the deflecting surface is defined on the second portion; wherein sealing means are provided between the body and the deflector so that when in the closed position fluid located exteriorly of the body is prevented from flowing into the bore of the deflector member (138, 140); wherein the deflecting surface faces diametrically away from the opening (136 may rotate on its up and down movement and the deflecting surface therefore may be facing any direction in the closed position); and wherein the deflecting surface is axially spaced from the opening in the closed position (figure 2).

In regard to the method claim 42, the use of the apparatus of Gano would encompass the steps as claimed.

Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Ohmer (US 6,209,645). Ohmer discloses a downhole deflector member comprising: a cylinder having a window provided in a side thereof (12) and having a ramp (30) defined on an interior surface thereof for deflecting, in use, downhole equipment through said window; wherein a bore extends longitudinally through the deflector member (20) so as to allow, in use, the passage of downhole equipment through the deflector member without deflection by the ramp; and wherein a portion of the bore which extends uphole from a base of said ramp (uppermost portion above where 33 is pointing) has a larger diameter

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than a remainder of said bore (through which 60 extends or 20), said remainder of said bore being located both uphole and downhole of the portion of the bore.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571)272-6558. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Bagnell/
Supervisory Patent Examiner, Art Unit 3672

DLA
10/8/08